REMARKS

Reconsideration of the above-identified application in view of the following remarks is respectfully requested.

Claims 16-20 have been objected to. Claims 16-20 have been amended as suggested by the Examiner to overcome this objection.

Claims 1, 8, and 10-13 have been rejected as unpatentable by Averbuch et al., US 5,896,566 in view of Dimenstein et al., US 2002/0086703. Claims 2-5 have been rejected as unpatentable by Averbuch et al. in view of Dimenstein et al. and Riordan et al, US 2003/0100297. Claims 6 and 7 have been rejected as unpatentable by Averbuch et al. in view of Dimenstein et al. and Kincaid, US 2004/0117785. Claim 9 has been rejected as unpatentable by Averbuch et al. in view of Dimenstein et al. and Ji et al., US 6,836,657. Claim 14 has been rejected as unpatentable by Averbuch et al. in view of Dimenstein et al. and Riordan. Claims 15 and 18-20 have been rejected as unpatentable by Averbuch et al. in view of Riordan. Claim 16 has been rejected as unpatentable by Averbuch et al. in view of Riordan and Dimenstein et al. Claim 17 has been rejected as unpatentable by Averbuch et al. in view of Riordan and Kincaid.

The Examiner's communication of July 26, 2006, together with the references cited therein, have been given careful consideration. After such consideration, and in an earnest effort to complete the prosecution of this application, the Applicants have set down the following arguments in support of the patentability of claims 1-20.

To assist the Examiner in reconsidering this application, the following is a presentation based on the language employed in claim 1 when read on the embodiment presented in Figs. 1-6 herein. Claim 1 recites a system for upgrading a plurality of mobile data acquisition devices. A software upgrade for use with the mobile data acquisition devices is located on a software management computer. The software management computer transfers the software upgrade from the software management computer to a local communications computer. The local communications computer transfers the software upgrade to a docking device. The docking device transfers the software upgrade to the mobile data acquisition devices when the mobile data acquisition devices are docked in the docking device. The docking device simultaneously recharges the mobile data acquisition devices and transfers the software upgrade to the mobile data acquisition devices.

Firstly, the Office Action states that Averbuch et al. discloses the docking device simultaneously recharging the mobile data acquisition devices and transferring the software upgrade to the mobile data acquisition devices (Office Action, page 3), citing Fig. 1 (108) and Col. 2, line 63 - Col. 3, line 6. It is respectfully submitted that these sections of Averbuch et al. do not disclose <u>simultaneous</u> recharging and upgrading.

Secondly, in rejecting claim 1 as obvious over Averbuch et al. in view of Dimenstein et al., the Office Action stated the following:

> At the time the invention was made, it would have obvious to one of ordinary skill in the art to implement the method of updating portable wireless communication units of Averbuch after modifying it to include a local communications computer attached to the docking device of Dimenstein. One of ordinary skill in the art would have been motivated to do this since connecting a docking device to a local communications computer enables the user to connect the mobile computing device to all the peripherals connected to the local computer and backup files from the mobile computing device on their local computer. (See Office Action, July 26, 2006, pages 3-4.

The Office Action cites Dimenstein et al., page 1, par. 0004, 0006, and 0020 for this motivation. Thus, it appears that the position of the Office Action is that it would have been obvious to add a step of communicating with a local communications computer to the method of Averbuch et al., as recited in claim 1, even though Averbuch et al. does not teach this feature.

The M.P.E.P. sets forth the following criteria for an obviousness rejection under 35 U.S.C. §103:

> To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

See, MPEP §706.02(j).

The structure of a computer, or computer-implemented system, programmed to carry out an algorithm is limited by the disclosed algorithm. *See* WMS Gaming Inc. v. Int'l Game Tech., 184 F.3d 1339, 1348 (Fed. Cir. 1999). A new machine (a

special purpose computer) is created when a general purpose computer is programmed to carry out an algorithm for performing one or more particular functions. Id. *citing* In Re Alappat, 33 F.3d 1526, 1545 (Fed. Cir. 1994) (*en banc*). When a general purpose computer is programmed to perform a particular function by using a discovery not specified in the prior art, the resulting device or system would not be obvious under 35 U.S.C. §103 "because one not having knowledge of the [inventor's] discovery simply would not know what to program the computer to do." *See* In re Prater, 415 F.2d 1393, 1397-98 (CCPA 1969).

For an obviousness rejection under 35 U.S.C. §103, the prior art must be analyzed at the time the invention was made. The use of the teachings of the present invention to find obviousness is impermissible.

> Obviousness must not be read into an invention on the basis of applicant's own statements; that is, the prior art must be viewed without reading into that art the applicant's teachings. The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of appellant's disclosure, make the invention obvious.

In Re Sponnoble, 160 USPQ 237, 243 (CCPA 1969) (emphasis in original). Accordingly, the Examiner must consider only the teachings of the prior art references.

As admitted in the Office Action, Averbuch et al. fails to teach or suggest a step of communicating with a local communications computer (Office Action, page 3). Therefore, it is clear that the features of claim 1 are not taught by Averbuch et al. According to WMS Gaming Inc., 184 F.3d at

1348, the system of claim 1 defines the algorithm for utilizing a local communications computer for upgrading a plurality of mobile data acquisition devices. Since Averbuch et al. admittedly fails to teach or suggest this feature, Averbuch et al. fails to teach or suggest a system as recited in claim 1. Since Averbuch et al. fails to teach or suggest each feature of the claimed invention, it is respectfully submitted that it would not have been obvious to one of ordinary skill in the art to combine Averbuch et al. and Dimenstein et al.

Additionally, when an algorithm is not taught or suggested by a prior art reference, one of ordinary skill in the art would not know what to program a computer to do. *See e.g.*, In re Prater, 415 F.2d at 1397-98. Thus, a new system has been created when a computer is programmed to carry out an algorithm to perform a particular function, as in claim 1. WMS Gaming Inc., 184 F.3d at 1348. Therefore, it is respectfully submitted that it would not have been obvious for one of ordinary skill in the art to utilize the method of Averbuch et al., in view of Dimenstein et al., to utilize a local communications computer. Thus, it is respectfully submitted that the rejection of claim 1 as obvious over Averbuch et al. in view of Dimenstein et al. is improper.

Furthermore, in rejecting claim 1 as obvious over Averbuch et al. in view of Dimenstein et al., it is respectfully suggested that improper hindsight has been used. Averbuch et al. fails to teach or suggest the use of a local communications computer. Thus, without reference to the

teachings of the disclosure of the present invention, one of ordinary skill in the art would not have the requisite knowledge to modify Averbuch et al. with Dimenstein et al. by utilizing a local communications computer, as recited in claim 1.

According to In Re Sponnoble, 160 USPQ at 243 (CCPA 1969), such hindsight is impermissible. Therefore, it is respectfully submitted that for this further reason, the rejection of claim 1 is improper.

Claim 1, as well as claims 2-10 which depend from claim 1, are in condition for allowance.

To assist the Examiner in reconsidering this application, the following is a presentation based on the language employed in claim 11 when read on the embodiment presented in Fig. 1 herein. Claim 11, as amended, recites a system for upgrading a software application. The system includes a data acquisition device, a software management computer, and a local communications computer. The data acquisition device is for use with the software application. The software management computer transmits an upgrade of the software application from the software management computer to the data acquisition device. The local communications computer interconnects the data acquisition device and the software management computer. The local communications computer transfers the upgrade from the software management computer to the data acquisition device. The local communications computer transfers the upgrade to at least one other data acquisition device. The local communications computer

includes a charging cradle for recharging a battery of the data acquisition device while providing direct line power to the data acquisition device. The charging cradle transfers the upgrade to the data acquisition device.

In rejecting claim 11 as obvious over Averbuch et al. in view of Dimenstein et al., the Office Action stated the following:

> At the time the invention was made, it would have obvious to one of ordinary skill in the art to implement the method of updating portable wireless communication units of Averbuch after modifying it to include a local communications computer attached to the docking device of Dimenstein. One of ordinary skill in the art would have been motivated to do this since connecting a docking device to a local communications computer enables the user to connect the mobile computing device to all the peripherals connected to the local computer and backup files from the mobile computing device on their local computer. (See Office Action, July 26, 2006, pages 3-4.

The Office Action cites Dimenstein et al., page 1, par. 0004, 0006, and 0020 for this motivation. Thus, it appears that the position of the Office Action is that it would have been obvious to add a step of communicating with a local communications computer to the method of Averbuch et al., as recited in claim 11, even though Averbuch et al. does not teach this feature.

The M.P.E.P. sets forth the following criteria for an obviousness rejection under 35 U.S.C. §103:

> To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

See, MPEP §706.02(j).

The structure of a computer, or computer-implemented system, programmed to carry out an algorithm is limited by the disclosed algorithm. *See* WMS Gaming Inc. v. Int'l Game Tech., 184 F.3d 1339, 1348 (Fed. Cir. 1999). A new machine (a special purpose computer) is created when a general purpose computer is programmed to carry out an algorithm for performing one or more particular functions. Id. *citing* In Re Alappat, 33 F.3d 1526, 1545 (Fed. Cir. 1994) (*en banc*). When a general purpose computer is programmed to perform a particular function by using a discovery not specified in the prior art, the resulting device or system would not be obvious under 35 U.S.C. §103 "because one not having knowledge of the [inventor's] discovery simply would not know what to program the computer to do." *See* In re Prater, 415 F.2d 1393, 1397-98 (CCPA 1969).

For an obviousness rejection under 35 U.S.C. §103, the prior art must be analyzed at the time the invention was made. The use of the teachings of the present invention to find obviousness is impermissible.

> Obviousness must not be read into an invention on the basis of applicant's own statements; that is, the prior art must be viewed without reading into that art the applicant's teachings. The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of appellant's disclosure, make the invention obvious.

In Re Sponnoble, 160 USPQ 237, 243 (CCPA 1969) (emphasis in original). Accordingly, the Examiner must consider only the teachings of the prior art references.

As admitted in the Office Action, Averbuch et al. fails to teach or suggest a step of communicating with a local communications computer (Office Action, page 3). Therefore, it is clear that the features of claim 11 are not taught by Averbuch et al. According to WMS Gaming Inc., 184 F.3d at 1348, the system of claim 11 defines the algorithm for utilizing a local communications computer for upgrading a plurality of mobile data acquisition devices. Since Averbuch et al. admittedly fails to teach or suggest this feature, Averbuch et al. fails to teach or suggest a system as recited in claim 11. Since Averbuch et al. fails to teach or suggest each feature of the claimed invention, it is respectfully submitted that it would not have been obvious to one of ordinary skill in the art to combine Averbuch et al. and Dimenstein et al.

Additionally, when an algorithm is not taught or suggested by a prior art reference, one of ordinary skill in the art would not know what to program a computer to do. *See e.g.*, In re Prater, 415 F.2d at 1397-98. Thus, a new system has been created when a computer is programmed to carry out an

algorithm to perform a particular function, as in claim 11. WMS Gaming Inc., 184 F.3d at 1348. Therefore, it is respectfully submitted that it would not have been obvious for one of ordinary skill in the art to utilize the method of Averbuch et al., in view of Dimenstein et al., to utilize a local communications computer. Thus, it is respectfully submitted that the rejection of claim 11 as obvious over Averbuch et al. in view of Dimenstein et al. is improper.

Furthermore, in rejecting claim 11 as obvious over Averbuch et al. in view of Dimenstein et al., it is respectfully suggested that improper hindsight has been used. Averbuch et al. fails to teach or suggest the use of a local communications computer. Thus, without reference to the teachings of the disclosure of the present invention, one of ordinary skill in the art would not have the requisite knowledge to modify Averbuch et al. with Dimenstein et al. by utilizing a local communications computer, as recited in claim 11.

According to In Re Sponnoble, 160 USPQ at 243 (CCPA 1969), such hindsight is impermissible. Therefore, it is respectfully submitted that for this further reason, the rejection of claim 11 is improper.

Claim 11, as well as claims 12-14 which depend from claim 11, are in condition for allowance.

To assist the Examiner in reconsidering this application, the following is a presentation based on the language employed in claim 15 when read on the embodiment presented in Fig. 1 herein. Claim 15, as amended, recites a computer program

product for upgrading a software application. The computer program product includes: a first instruction for initiating communication between a mobile device and a software management computer; a second instruction for initiating transfer of an upgraded portion of the software application from the software management computer to the mobile device; a third instruction for updating a master bill of materials index file by the software management computer reflecting the upgrade of the software application; and a fourth instruction for recharging the mobile device and powering the mobile device with direct line power (Specification, page 7, lines 1-14).

In rejecting claim 15 as obvious over Averbuch et al. in view of Riordan et al., the Office Action stated the following:

> At the time the invention was made, it would have obvious to one of ordinary skill in the art to implement the software updating of Averbuch after modifying it to incorporate a bill of materials for software version verification of Riordan. One of ordinary skill in the art would have been motivated to do this since it version verification ensures mobile device compatibility with the wireless network. (See Office Action, July 26, 2006, page 10.

The Office Action cites Riordan et al., page 1, par. 0004, 0013, and 0014 for this motivation. Thus, it appears that the position of the Office Action is that it would have been obvious to add a step of utilizing a bill of materials to verify software version to the method of Averbuch et al., as recited in claim 15, even though Averbuch et al. does not teach this feature.

The M.P.E.P. sets forth the following criteria for an

obviousness rejection under 35 U.S.C. §103:

> To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

See, MPEP §706.02(j).

The structure of a computer program product, programmed to carry out an algorithm, is limited by the disclosed algorithm. *See* WMS Gaming Inc. v. Int'l Game Tech., 184 F.3d 1339, 1348 (Fed. Cir. 1999). A new machine (a special purpose computer) is created when a general purpose computer is programmed to carry out an algorithm for performing one or more particular functions. Id. *citing* In Re Alappat, 33 F.3d 1526, 1545 (Fed. Cir. 1994) (*en banc*). When a general purpose computer is programmed to perform a particular function by using a discovery not specified in the prior art, the resulting device or system would not be obvious under 35 U.S.C. §103 "because one not having knowledge of the [inventor's] discovery simply would not know what to program the computer to do." *See* In re Prater, 415 F.2d 1393, 1397-98 (CCPA 1969).

For an obviousness rejection under 35 U.S.C. §103, the prior art must be analyzed at the time the invention was made. The use of the teachings of the present invention to find obviousness is impermissible.

> Obviousness must not be read into an invention on the basis of applicant's own statements; that is, the prior art must be viewed without reading into that art the applicant's teachings. The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of appellant's disclosure, make the invention obvious.

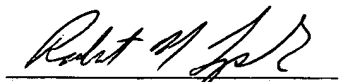
In Re Sponnoble, 160 USPQ 237, 243 (CCPA 1969) (emphasis in original). Accordingly, the Examiner must consider only the teachings of the prior art references.

As admitted in the Office Action, Averbuch et al. fails to teach or suggest a step of utilizing a bill of materials for software version verification (Office Action, page 10). Therefore, it is clear that the features of claim 15 are not taught by Averbuch et al. According to WMS Gaming Inc., 184 F.3d at 1348, the system of claim 15 defines the algorithm for utilizing a bill of materials for software version verification. Since Averbuch et al. admittedly fails to teach or suggest this feature, Averbuch et al. fails to teach or suggest a system as recited in claim 15. Since Averbuch et al. fails to teach or suggest each feature of the claimed invention, it is respectfully submitted that it would not have been obvious to one of ordinary skill in the art to combine Averbuch et al. and Riordan et al.

Additionally, when an algorithm is not taught or suggested by a prior art reference, one of ordinary skill in the art would not know what to program a computer to do. *See e.g.*, In re Prater, 415 F.2d at 1397-98. Thus, a new system has been created when a computer is programmed to carry out an algorithm to perform a particular function, as in claim 15.

Please charge any deficiency or credit any overpayment in the fees for this election to our Deposit Account No. 20-0090.

Respectfully submitted,



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